

Appl. No. 10/633,807
Amtd. dated July 3, 2007
Reply to Office Action of April 4, 2007

8894.01-1

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REMARKS/ARGUMENTS

Claims 1, 3, 4, 10, 11, 13, 15-17, 19 and 20 remain in this application. Claims 2, 12, 14 and 18 are canceled. Claims 5-9 are withdrawn from consideration as directed to non-elected species. Claims 21-50 are withdrawn from consideration as directed to a non-elected invention.

Applicant appreciates the courtesies extended to applicant's attorney in the telephone interview with the Examiner on July 2, 2007. The rejections of the claims and possible amendments to claims 1 and 10 were discussed in the course of the interview. While no agreement with the Examiner was reached regarding amendments to the claims, applicant has amended claims 1 and 10 to incorporate limitations from claim 18 regarding a controller to operate one or more simulated opponents.

Reconsideration and reexamination is respectfully requested.

Claims 1, 4, 10 and 11 are rejected under 35 U.S.C. 102 (b) as being anticipated by the Passing Shot Drill described in "Competitive Tennis" (Competitive Tennis). The rejection is respectfully traversed. Claims 1 and 10 have been amended to include limitations previously found in claim 18.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor, Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim." MPEP §2131.

Claim 1 as amended sets forth a method for training sports skills for a game conducted on a playing surface that includes ... "sequentially projecting a plurality of game objects toward one portion of said playing surface for striking by one or more players being trained; and sequentially

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causing one or more simulated opponents to appear at two or more locations on said playing surface in connection with projection of a game object to train said player to strike game objects away from an opponent; wherein said one or more simulated opponents are controlled by a controller and wherein said method included setting said controller to operate said one or more simulated opponents to simulate one or more players having a selected skill level" (emphasis added). Similarly, claim 10 as amended sets forth a method for training tennis skills that includes ... "sequentially projecting a plurality of tennis balls toward one side of a tennis court for return by said tennis player; and sequentially causing one or more simulated opponents to appear at two or more locations on the opposite side of said tennis court in connection with projection of a tennis ball to train said tennis player to return tennis balls away from an opponent thereby teaching said tennis player to play the tennis court and training placement memory in the brain of said tennis player in addition to muscle memory by returning said tennis balls; wherein said one or more simulated opponents are controlled by a controller and wherein said method includes setting said controller to operate said one or more simulated opponents to simulate one or more tennis players having a selected skill level" (emphasis added).

Competitive Tennis at pages 207 and 208 describes a Passing Shot Drill in which "Player A starts the drill by feeding the ball to one of three spots: the forehand side, the backhand side, or right at Player B (see figure 4.16). Player B has to hit the ball past Player A, aiming for the targets shown in figure 4.16." Player A is not described as a simulated opponent, Player A does not appear at two or more locations on the opposite side of the tennis court, and further, Player A is not described as being controlled by a controller and the Passing Shot Drill does not disclose or suggest setting the controller to operate said one or more simulated opponents to simulate one or more players (claim 1) or tennis players (claim 10) having a selected skill level.

Since each and every element of applicant's invention as set forth in claims 1, 4, 10 and 11 is not supported by the art as set forth above applicant respectfully submits the rejection of claims 1, 4, 10 and 11 as being anticipated by Competitive Tennis is defective and should be withdrawn.

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Claims 2, 3, and 12-17 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Competitive Tennis as applied above. Claims 2, 12 and 14 have been canceled. The rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (emphasis added). *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §2142. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03.

As set forth above, Competitive Tennis at pages 207 and 208 describes a Passing Shot Drill in which "Player A starts the drill by feeding the ball to one of three spots: the forehand side, the backhand side, or right at Player B (see figure 4.16). Player B has to hit the ball past Player A, aiming for the targets shown in figure 4.16." Player A is not described as a simulated opponent, Player A does not appear at two or more locations on the opposite side of the tennis court, and further, Player A is not described as being controlled by a controller and the Passing Shot Drill does not disclose or suggest setting the controller to operate said one or more simulated opponents to simulate one or more players (claim 1) or tennis players (claim 10) having a selected skill level.

Regarding claims 3 and 13, Competitive Tennis does not disclose or suggest a machine for sequentially projecting a plurality of game object (claim 3) or one or more tennis ball machines projecting a plurality of tennis balls (claim 13) toward one side of the playing surface (claim 3) or tennis court (claim 10) for striking by the player (claim 3) or tennis player (claim 10) being trained. Thus, Competitive Tennis not only fails to disclose or suggest the method set forth in independent claims 1 and 10 as set forth above, but also fails to disclose or suggest the additional limitations set forth in dependent claims 3 and 13.

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Regarding claim 15, Competitive Tennis does not disclose or suggest a simulated opponent or operating one or more simulated opponents to simulate one or two tennis players moving to a plurality of locations on the opposite side of the tennis court. Rather, Competitive Tennis discloses a Player A located in a fixed position and a plurality of targets. "Player B has to hit the ball past Player A, aiming for the targets shown in figure 4.16", (see Competitive Tennis, page 208). Applicant respectfully submits that if Player A in the Competitive Tennis Passing Shot Drill is caused to move to a plurality of positions the drill would no longer be a passing shot drill as intended. Thus, Competitive Tennis not only fails to disclose or suggest the method set forth in independent claim 10 as set forth above, but also fails to disclose or suggest the additional limitations set forth in dependent claim 15.

Regarding claims 16 and 17, Competitive Tennis does not disclose or suggest ... "a plurality of stationary simulated opponents located in selected locations on the opposite side of said tennis court and said step of operating said one or more simulated opponents comprises operating selected ones of said simulated opponents to cause an opponent to selectively appear at said one or more of said locations" (claim 16), or simulated opponents [that] ... "comprise one or more movable simulated opponents and said step of operating said one or more simulated opponents comprises operating selected ones of said simulated opponents to move said one or more simulated opponents to selectively appear at two or more of a plurality of locations on the opposite side of the tennis court" (claim 17). Thus, Competitive Tennis not only fails to disclose or suggest the method set forth in independent claim 10 as set forth above, but also fails to disclose or suggest the additional limitations set forth in dependent claims 16 and 17.

Accordingly, applicant respectfully submits that the third criteria required to establish a *prima facie* case of obviousness has not been met since Competitive Tennis simply does not disclose or suggest all the elements of claims 3, 12, 13 and 15-17 for all the reasons discussed above.

Thus, applicant respectfully submits that the rejection of claims 3, 12, 13, and 15-17 as unpatentable over Competitive Tennis fails to satisfy the third criteria required to establish *prima*

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facie obviousness, namely that "all the claim limitations must be taught or suggested by the prior art". *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03.

Accordingly, applicant respectfully submits that the rejection of claims 3, 12, 13, and 15-17 is defective for failing to establish *prima facie* obviousness of the rejected claims in view of the cited prior art since the third criteria necessary to establish *prima facie* obviousness has been met, and the rejection of claims 3, 12, 13 and 15-17 should be withdrawn.

Further, regarding claims 3, 12, 13 and 15-17, applicant respectfully submits that the rejection of claims 3, 12, 13 and 15-17 is defective for failing to establish *prima facie* obviousness for the same reasons as set forth above with respect to claims 1 and 10 on which claims 3, 12, 13 and 15-17 respectively depend. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1956 (Fed. Cir. 1988)." MPEP §2143.03

The Examiner has acknowledged that claims 18-20 are directed to allowable subject matter. As noted above, limitations in claim 18 have been added to claims 1 and 10 and claim 18 has been canceled. Applicant respectfully submits that claims 19 and 20, now dependent on claim 10 are allowable since limitations formerly in claim 18 are now presented in claim 10.

Summary

Applicant respectfully submits that claims 1, 3-4, 10-11, 13, 15-17 and 19-20 are now in condition for allowance and requests that the claims be allowed.

Upon allowance of generic claims 1, 3 and 4 applicant respectfully requests that non-elected species claims 5 – 9 be considered. Applicant proposes to amend claim 5 in a manner similar to claim 1 and respectfully submits that, so amended, claim 5 and accordingly dependent claims 6-9 would also be allowable.

In view of the Examiner's earlier restriction requirement, applicant retains the right to present claims 21 – 50 as a divisional application.

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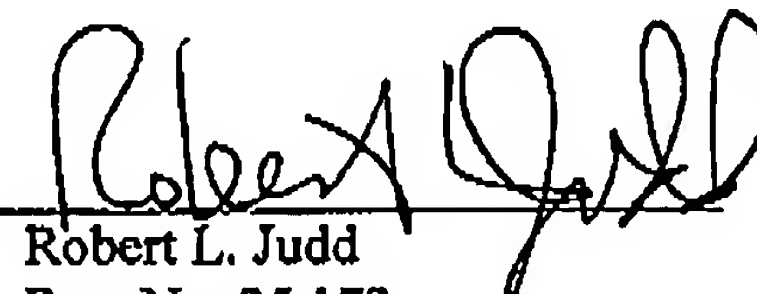
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For the reasons presented above, it is believed that the application, as now presented, is in condition for allowance, and that there are no remaining issues in the application. Allowance of the application as now presented, and passing of the application to issue are respectfully solicited.

Further and favorable action is respectfully requested.

Respectfully submitted,

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Dated: July 3, 2007